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Francisco Javier Romero Amaya

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EXAMINER

SCHLENTZ, NATHAN W

ART UNIT

PAPER NUMBER

1616

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/537,192	<b>Applicant(s)</b> ROMERO AMAYA, FRANCISCO JAVIER	
	<b>Examiner</b> Nathan W. Schlientz	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-15 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-15 and 18-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/18/08</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 12, 16 and 17 were cancelled and claims 18-27 newly added in an amendment filed 08 July 2008. As a result, claims 1-11, 13-15 and 18-27 are pending and thus examined herein on the merits for patentability. No claim is allowed at this time.

### ***Information Disclosure Statement***

The information disclosure statement filed 18 July 2008 has been fully considered. However, the documents that have been lined through are duplicates from IDS's filed previously that were considered by the examiner on 08 January 2008.

### ***Response to Arguments***

Applicant's Remarks filed 08 July 2008 have been fully considered and are discussed herein below.

### ***Withdrawn Rejections***

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-11, 13-15 and 18-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 1 states, "the wood product after the superficial treatment does not require re-drying." However, the instant specification does not define what is meant by re-drying. The only mention of re-drying in the specification is at page 7, lines 10-12, wherein the specification states, "Wood treated according to the invention not required re-drying after treatment. Normal process required re-drying when the end use is framing." It is the examiners position that after application of the active in a solvent or carrier, merely allowing the wood product to sit at ambient conditions is a drying step. As a matter of fact, the moment the wood product is removed from the source of application (i.e., dipping, rolling, brushing, misting or spraying), the product inherently begins to dry as the solvent or carrier begins to evaporate. Therefore, in the absence of evidence to the contrary, the method of applying a superficial treatment of bifenthrin to a wood product inherently has a re-drying step after application. For the purposes of search and examination of the instant claims, the examiner is construing the claims in the absence of the limitation that the wood product does not require re-drying.

Art Unit: 1616

2. Claims 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "significantly penetrate" in claims 24 and 25 is a relative term which renders the claim indefinite. The term "significantly penetrate" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The instant specification at pages 2 and 3 merely state that until this invention adequate protection of timber against termite attack required significant penetration, whereas the instant invention does not require significant penetration of bifenthrin. However, the instant specification does not define how much penetration is significant penetration, nor does the specification provide a standard for ascertaining the requisite degree that would lead one of ordinary skill in the art to understanding or determining the amount of penetration that is considered significant.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 2, 6, 10, 11, 14, 20, 22 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kodama et al. (US 5,747,519).

Art Unit: 1616

Kodama et al. disclose a composition comprising a compound of formula (I) and a pyrethroid compound, such as bifenthrin, wherein the composition may be applied to (i.e., superficial treatment) or adsorbed in (i.e., impregnating) building materials (col. 1, ll. 32-42; col. 2, ll. 6-10 and 38-40; col. 3, ll. 21-24, 27-45; and claim 11). Kodama et al. further disclose that the composition may be formulated into forms suited to the object of use, such as an oil solution, emulsion, water solution, powder, granules, wettable powder, aerosol, etc. (col. 3, ll. 37-45); as well as the use of auxiliary agents and liquid vehicles, such as organic solvents (col. 3, l. 46 to col. 4, l. 9). Kodama et al. also disclose examples of compositions comprising bifenthrin for the treatment of wood, such as timber products like plywood, particle boards and half boards (col. 4, ll. 13-20; Embodiments 1 and 2 in Examples; and Table 1). Therefore, Kodama et al. clearly disclose treating wood, such as timber or all kinds of wood, by spraying the wood with bifenthrin.

### ***Response to Arguments***

Applicants argue on page 9 that Kodama et al. do not teach a superficial treatment of a wood product with bifenthrin in a solvent or carrier, such that the wood product after the superficial treatment does not require re-drying. However, the examiner respectfully argues that Kodama et al. discloses that the composition may be applied to (i.e., superficial treatment) or adsorbed in (i.e., impregnating) building materials (col. 3, ll. 33-34).

Applicants also argue that Kodama et al. do not disclose methods of treating a wood product with a bifenthrin concentrate or, specifically, a suspension concentrate,

Art Unit: 1616

emulsion concentrate, microemulsion or dust. However, the examiner respectfully argues that Kodama et al. disclose that the compositions of their invention may be formulated as emulsions (col. 3, ll. 42-44). It is noted that the instant claims do not require a concentration range of bifenthrin within the “concentrate”. Therefore, the compositions of Kodama et al. anticipate the instant claims.

2. Claims 1, 2, 6, 10, 11, 14, 20, 22 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wimmer et al. (CA 2 321 353).

Wimmer et al. disclose a wood preservative comprising a cyclodextrin, tebuconazole, propiconazole and **bifenthrin** (page 4, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs; page 14, Example 7; page 15, Example 8; and claims 10 and 11). Wimmer et al. further disclose a method of protecting wood and timber materials by treating said wood or timber with the preservative composition comprising bifenthrin (claim 18). Also, Wimmer et al. disclose that the wood preservative may also comprise colorants (page 6, line 21; and claim 15), and may be applied to wood by known means, such as painting on, spraying or impregnating methods such as dipping, immersing, and the pressure, vacuum and double-vacuum methods (page 9, 3<sup>rd</sup> paragraph).

### ***Response to Arguments***

Applicants argue on page 9 that Wimmer et al. disclose improved depth of penetration, and thus teach away from a superficial treatment of wood using bifenthrin. However, the examiner respectfully argues that Wimmer et al. teach wood treated in an immersion bath with the formulation of their invention, wherein the depth of penetration

Art Unit: 1616

was 2 or 4 mm (Example 11, Table 1). It is noted that the instant claims and specification do not define significant penetration as discussed above. Therefore, the method of immersing the wood in an immersion bath anticipates the instant claims.

Applicants also argue that Wimmer et al. do not disclose superficial treatment of wood with bifenthrin as either a concentrate or diluted in a solvent or carrier, such that the wood does not require re-drying. However, the examiner respectfully argues that the instant specification does not define re-drying, as discussed above. Wimmer et al. disclose that the compositions may be applied to wood by known means, such as painting on, spraying or impregnating methods such as dipping, immersing, and the pressure, vacuum and double-vacuum methods (page 9, 3rd paragraph). Therefore, Wimmer et al. disclose methods of superficially treating the wood.

3. Claims 1, 10, 11, 14 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahide et al. (JP 11-207706).

Takahide et al. disclose an antiseptic insecticide for wood comprising a wood antiseptic and insecticide, such as bifenthrin, diluted with water (Abstract). Therefore, Takahide et al. disclose applying an antiseptic insecticide comprising bifenthrin to wood.

### ***Response to Arguments***

Applicants argue on page 10 that the methods of Takahide et al. require a drying step. However, it is requested that Applicants direct the examiner's attention to the portion of Takahide et al. wherein it is disclosed that the methods require a drying step, as the examiner does not find support for this argument. Also, as discussed above, the



Art Unit: 1616

instant specification does not define re-drying, and the method as instantly claimed would inherently possess a drying step after the wood product is removed from the source of application.

4. Claims 1, 2, 6, 7, 9-11, 13-15, 20, 22 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Shires et al. (The International Research Group on Wood Preservation, 19-24 May 1996).

Shires et al. disclose bifenthrin as a suitable wood preservative (Title). Shires et al. disclose treating Scots pine sapwood (*Pinus sylvestris* L.) and beech wood (*Fagus sylvatica* L.) with a light organic solvent product (LSOP) based on an aliphatic solvent, by spraying with a pipette or micro emulsion (ME) concentrate by dipping and double vacuum comprising bifenthrin and a ceresblue dye (Section 2.1), as well as applying the bifenthrin composition by brushing (Section 2.2). Shires et al. further disclose a superficial treatment of the pine and beech wood with the LSOP composition comprising bifenthrin which gives a loading of 3.5 to 14.5 g/m<sup>3</sup> bifenthrin at a depth of 3 mm (Section 3.1 and Table 2).

### ***Response to Arguments***

Applicants argue on page 11 that in contrast to the instant invention, the methods of Shires et al. produce significant bifenthrin penetration into the wood product, such that re-drying of the wood product is required. However, the examiner respectfully argues that the instant specification does not define significant penetration, as discussed above. Also, the instant specification does not define re-drying, as discussed

Art Unit: 1616

above. Shires et al. disclose conditioning the wood for 4 weeks in a controlled climate room at 65% relative humidity and 20 °C to assure complete fixation of bifenthrin to the wood matrix. It is not clear from the specification that the controlled climate room disclosed by Shires et al. constitutes re-drying conditions.

Applicants also argue on page 11 that Shires et al. do not disclose methods of treating a wood product with bifenthrin in the form of a suspension concentrate, emulsion concentrate, microemulsion or dust. However, the examiner respectfully argues that Shires et al. disclose a dipping treatment with water diluted micro-emulsion comprising 0.012% bifenthrin, which resulted in a loading of 6.4 to 9.7 g/m<sup>3</sup> (Section 3.1, "Dipping").

5. Claims 1, 10, 11, 14, 20, 22 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Jaetsch et al. (EP 1 018 413).

Jaetsch et al. disclose insecticidal treatment of the backside of plywood with bifenthrin, nonyphenol, formalinchatcher, water, and other solvents (page 7). Therefore, Jaetsch et al. disclose a method of treating timber with bifenthrin as well as the timber product comprising bifenthrin.

### ***Response to Arguments***

Applicants argue on page 13 that the methods of Jaetsch et al. do not teach methods for the superficial treatment of a wood product with bifenthrin, and Applicants quote [0018] and [0019] of Jaetsch et al. However, the examiner respectfully argues that Jaetsch et al. disclose uniformly coating plywood with a bifenthrin-containing

Art Unit: 1616

adhesive followed by applying a slice veneer (Example of comparison 4, Example of execution 5, and Comparison example 5). Therefore, application of an adhesive containing bifenthrin to the backside of plywood prior to adding a slice veneer anticipates superficially treating a wood product with bifenthrin.

6. Claims 1, 2, 10, 11, 14, 20, 22 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu (US 5,536,305).

Yu discloses applying bifenthrin to freshly sawn timber via pressure treatment, vacuum treatment, dipping, brushing, spraying, or soaking (col. 2, ll. 4-7 and 13; col. 4, ll. 26-34; and claims 1-5). Yu further discloses that surfactants, adjuvants including antifoam agents, antifreeze agents, wetting agents, thickeners, and the like can be added to composition, as well as organic solvents (col. 2, ll. 17-18, 34-35, and 52-59; and claims 2 and 3). Yu also discloses that the composition is suitable for dilution with water to form a microemulsion or an emulsion, wherein the microemulsion or emulsion is applied to the wood (i.e., lumber, timber, posts, wood coverings, wicker, millwork, joinery, plywood, fiberboard, chipboard, waferboard, particleboard, etc) (col. 1, ll. 13-17; and col. 2, ll. 36-39).

### ***Response to Arguments***

Applicants argue on page 14 that the method of Yu requires a re-drying step, as seen in Example 2 wherein Yu discloses that wood blocks were placed in a fume hood for 2 days and then placed in a conditioning room for 21 days. However, the examiner respectfully argues that, as discussed above, the instant specification does not define

Art Unit: 1616

re-drying, and the method as instantly claimed would inherently possess a drying step after the wood product is removed from the source of application.

7. Claims 1-5, 10, 11, 14, 24, 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakabayashi et al. (JP 2000-225607; machine-generated English language translation referred to herein).

Nakabayashi et al. disclose spraying a solution comprising 0.05% bifenthrin in a petroleum solvent onto the surface of incising processed wood (Abstract; and [0035]). Nakabayashi et al. disclose spraying the wood with a plurality of nozzles whereby the fluid can be easily and uniformly applied to the surface of the wood (Abstract; and Figures 9-11).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1,148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 1616

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kodama et al., Wimmer et al., Shires et al., and Yu in view of Heitmanek (US 4,894,262).

#### **Applicant's claims**

Applicants claim a method of timber preservation by spraying bifenthrin on the timber product at a sawmill with a linear sprayer after stress grading and a second spray with a transverse sprayer after a docker saw operation.

#### **Determination of the scope and content of the prior art**

##### **(MPEP 2141.01)**

The teachings of Kodama et al., Wimmer et al., Shires et al., and Yu are discussed above and incorporated herein by reference.

#### **Ascertainment of the difference between the prior art and the claims**

##### **(MPEP 2141.02)**

Kodama et al., Wimmer et al., Shires et al., and Yu do not teach spraying the timber with bifenthrin at a sawmill with a linear sprayer after stress grading and a second spray with a transverse sprayer after a docker saw operation. However, it is commonly known in the art that the use of stress-graded timber is for structural use, it is a critical safety element of construction and the use of strength-graded timber is required by Building Regulations. Also, Heitmanek teaches treating lumber by spraying at the sawmill to seal the sides and ends to maintain the moisture content of the wood (col. 1, ll. 10-55).

**Finding of *prima facie* obviousness**

**Rational and Motivation (MPEP 2142-43)**

Therefore, it would have been *prima facie* obvious for one skilled in the art at the time of the invention to apply the bifenthrin composition to the timber product of Kodama et al., Wimmer et al., Shires et al., and Yu while the timber product is at the sawmill and has been stress graded and freshly cut by a docker saw in order to seal/protect the sides and the ends, as reasonably taught by Heitmanek. Also, one of ordinary skill in the art would want to apply the bifenthrin preservative after cutting with a docker as opposed to prior to cutting with the docker saw in order to prevent exposing unprotected portions of the timber.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

***Response to Arguments***

Applicant's arguments with respect to the 102(b) rejections over Kodama et al., Wimmer et al., Shires et al., and Yu above are relied upon herein. Applicants argue on page 15 that Heitmanek does not overcome the deficiencies of Kodama et al., Wimmer et al., Shires et al., and Yu. Therefore, the examiners responses to arguments, as discussed above, are relied upon herein.

Art Unit: 1616

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kodama et al., Wimmer et al., Takahide et al., Shires et al., Jaetsch et al., Yu and Nakabayashi et al. in view of Richardson (Wood Preservation, 1993).

**Applicant claims:**

Applicants claim a method of timber product preservation comprising applying bifenthrin to the timber product while the product is warmer than room temperature.

**Determination of the scope and content of the prior art**

**(MPEP 2141.01)**

The teachings of Kodama et al., Wimmer et al., Takahide et al., Shires et al., Jaetsch et al., Yu and Nakabayashi et al. are discussed above and incorporated herein by reference.

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Kodama et al., Wimmer et al., Takahide et al., Shires et al., Jaetsch et al., Yu and Nakabayashi et al. do not teach treating timber with bifenthrin while the wood is warmer than room temperature, as instantly claimed. However, it is very common to treat wood with preservatives wherein the wood is at elevated temperatures, as evidenced by Richardson (pg. 67, Treatment Temperature).

**Finding of *prima facie* obviousness**

**Rational and Motivation (MPEP 2142-43)**

Therefore, it would have been *prima facie* obvious for one skilled in the art at the time of the invention to treat the timber product of Kodama et al., Wimmer et al.,

Art Unit: 1616

Takahide et al., Shires et al., Jaetsch et al., Yu and Nakabayashi et al. with bifenthrin while the wood was warmer than room temperature, as reasonably taught by Richardson.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

3. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kodama et al., Wimmer et al., Takahide et al., Shires et al., Jaetsch et al., Yu and Nakabayashi et al. in view of Creffield et al. (The International Research Group on Wood Preservation, 12-17 May 2002).

#### **Applicant's claims**

Applicants claim the methods of claims 20 and 22 wherein the wood product is radiate pine.

#### **Determination of the scope and content of the prior art**

##### **(MPEP 2141.01)**

The teachings of Kodama et al., Wimmer et al., Takahide et al., Shires et al., Jaetsch et al., Yu and Nakabayashi et al. are discussed above and incorporated herein by reference.



**Ascertainment of the difference between the prior art and the claims****(MPEP 2141.02)**

Kodama et al., Wimmer et al., Takahide et al., Shires et al., Jaetsch et al., Yu and Nakabayashi et al. do not teach the wood product to comprise radiate pine, as instantly claimed. However, Creffield et al. teach treating *P. radiata* sapwood specimens to a nominal retention of 2.5, 5, 10, 15, 20, 30 and 50 g/m<sup>3</sup> of bifenthrin with white spirit used as the solvent, wherein the bifenthrin formulation was a 100 g/L emulsifiable concentrate (page 3, Field Trial; and Tables 1 and 2).

**Finding of *prima facie* obviousness****Rational and Motivation (MPEP 2142-43)**

Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art at the time of the invention to treat wood products with bifenthrin, as taught by Kodama et al., Wimmer et al., Takahide et al., Shires et al., Jaetsch et al., Yu and Nakabayashi et al., wherein the wood product is radiate pine, as reasonably taught by Creffield et al.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Art Unit: 1616

4. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wimmer et al., Shires et al., and Yu.

**Applicant's claims**

Applicants claim a method according to claim 1, wherein the wood product is treated by dipping in the bifenthrin composition for four seconds.

**Determination of the scope and content of the prior art**

**(MPEP 2141.01)**

The teachings of Wimmer et al., Shires et al., and Yu are discussed above and incorporated herein by reference.

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Wimmer et al., Shires et al., and Yu do not explicitly teach that the amount of time for dipping the wood product in the bifenthrin composition is 4 seconds, as instantly claimed. However, it would have been well within the purview of one of ordinary skill in the art to vary dipping times in order to determine the most efficacious application of bifenthrin to the wood product.

**Finding of *prima facie* obviousness**

**Rational and Motivation (MPEP 2142-43)**

Therefore, it would have been *prima facie* obvious for one skilled in the art at the time of the invention to apply the bifenthrin composition to the timber product by dipping, as taught by Wimmer et al., Shires et al. and Yu, while determining the optimal amount

Art Unit: 1616

of time for which the wood product must remain dipped in order to achieve maximal insecticide efficacy.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1616

### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Schlientz whose telephone number is 571-272-9924. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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